



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 1632

In re

Patent Application of

Kevin J. Rozeboom, et. al.

Application No. 10/081,097

Confirmation No. 2833

Filed: February 21, 2002

Examiner: Vera Afremova

"COMPOSITIONS COMPRISING
REPRODUCTIVE CELL MEDIA AND
METHODS FOR USING SUCH COMPOSITIONS
"

I, Vicki Posekany, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Vicki Posekany
Signature

June 2, 2003 RECEIVED

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated April 2, 2003, Applicants respectfully submit the following response. Accompanying this response is a one month extension of time, extending the date for response to June 2, 2003. Applicants, therefore, submit that the response is timely filed.

The Office Action stated that restriction to one of the following patently distinct groups is required under 35 USC 121: Group I (claims 1-18, 23-32, 48 and 49) directed towards a sperm medium composition with at least one growth factor, Group II (claims 19-22) directed towards a reproductive cell medium composition with zinc, Group III (claim 33) directed towards a sperm medium composition with transferrin, Group IV (claims 34-46 and 50-52) directed towards a reproductive cell medium composition with activated growth factors, Group V (claim 47) directed towards a reproductive cell medium composition with

inositol, and Group VI (claim 53) directed towards a method for collecting, processing and storing sperm cells.

In response to the above noted restriction requirement, Applicants hereby elect the claims of Group I (i.e. claims 1-18, 23-32, 48 and 49) with traverse.

The Applicants hereby traverse the restriction requirement in it's entirety. Restriction is only proper where "two or more independent and distinct inventions are claimed in one application." (35 U.S.C. §121). Applicants respectfully submit that the six groups of claims identified by the Examiner in the Office Action are not directed to "independent and distinct inventions", but to different embodiments of the same invention. The present invention consists of a sperm medium composition which can contain various components, and methods of using the compositions.

One embodiment of the present invention is a composition comprising a sperm cell medium and at least one growth factor selected from the group consisting of insulin-like growth factors and transforming growth factors, including activated growth factors. (claims 1-18, 23-32, 48 and 49:Group I, claim 20:Group II, and claims 34-46 and 50-52, Group IV). Another embodiment of the present invention is a composition comprising the reproductive cell medium along with zinc (claim 48:Group I, claims 19-22:Group II). Yet another embodiment is a composition comprising a reproductive cell medium and transferrin (claims 18:Group I, claim 22:Group II, claim 33:Group III). Yet another embodiment is drawn to a reproductive cell medium and activated growth factors (claims 34-46 and 50-52:Group IV). Yet another embodiment of the invention is a composition comprising a reproductive cell medium and inositol (claim 18:Group I, claim 22:Group II, claim 47:Group V) in a method for using the composition comprising a reproductive cell medium (claim 53, Group VI).

As is clear from above, the composition claims of the present invention contain significant overlap between the claims of Groups I-V. The central claimed subject matter of the present invention are novel compositions comprising a reproductive cell medium. As should be clear from the disclosures of the invention embodiments, the reproductive cell medium is an essential component in each and every embodiment of the present invention. Applicants submit that the claims of Groups I-VI are, therefore, not directed to separate and distinct inventions, but to the same invention. Thus, restriction to any of the groups of claims is improper, under 35 U.S.C. § 121.

Applicants submit, furthermore, that even if the claim groups were directed to independent or distinct inventions, rather than to the embodiments of the same invention, restriction would not be appropriate in this case for the following reasons. The Manual of Patent Examining Procedure (“MPEP”) states that:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP § 803.

Applicants respectfully submit that all the claims of the present application could be examined together without placing any serious burden on the United States Patent and Trademark Office (hereinafter “Patent Office”). The claims of Groups I-VI are so inextricably related to one another that, for the sake of efficiency, they should be examined in a single application. All the claims are directed to compounds and kits comprising a reproductive sperm cell medium or methods using such a compound. A complete search of all the prior art relating to this compound would necessarily require a search of all the subject matter of all the groups. Given the close relationship between the claims of Groups I-VI, prosecution in the same application would be administratively efficient for the Patent Office.

Specifically, by prosecuting the applications together, searches could be consolidated and one examiner could readily examine the subject matter of all the claims of this application at once.

Applicants submit that with the arguments presented herein, claims 1-53 are not directed to separate and distinct inventions, but to the same invention, and, therefore, restriction is improper. Applicants respectfully submit that claims 1-53 are in condition for allowance.

Respectfully submitted,



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